



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/719,464 | 11/21/2003 | Michael D. Bella | 57551-00004USPT | 2601 |
| JENKENS & GILCHRIST, P.C. Suite 3200 1445 Ross Avenue Dallas, TX 75202-2799 | | | | |
| EXAMINER NGUYEN, TAN D | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3689 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/30/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,464

Applicant(s)

BELLA ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 4/1/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 4/1/05 was filed after the mailing date of the application on 11/21/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 3689

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of SCHWARTZ ET AL or.

As of 11/21/03, claim 1 is as followed:

1. A method for obtaining approval of a mailing list campaign, comprising the steps of:

a) forwarding a proposed mailing list campaign sample to a list owner via a computer network;

b) determining if the list owner replies to the proposed mailing list campaign sample; and

c) implementing the mailing list campaign in accordance with the step of determining.

Note: for convenience, letters (a)-(c) are added to the beginning of each step.

AAPA, as shown on pages 2-3, fairly teaches a method for obtaining approval of a mailing list campaign, comprising the steps of:

a) forwarding a proposed mailing list campaign sample to a list owner via mailing;

b) determining if the list owner replies to the proposed mailing list campaign sample; and

c) implementing the mailing list campaign in accordance with the step of determining, wherein the determining is carried out via telephone (see page 2, last line to page 3, line 7).

In a similar method for conducting a business campaign, **SCHWARTZ ET AL** disclose the inefficient way of conducting a business campaign by mail and telephone or traditional communication media between involved entities by mail or telephones which are slow and high administrative cost, and replacing the inefficient communication with the computer network via the Internet or World Wide Web (see paragraphs [0002], [0007], [0008], [0009] and [0015]. It would have been obvious to replace the traditional communication media of AAPA with the Internet or World Wide Web as taught by SCHWARTZ ET AL for the benefits cited above (see 0006]-[0008]).

As for dep. claims 2-3 (part of 1 above), which deals with the computer network parameter, i.e. Internet, this is taught in SCHWARTZ ET AL Figs. 1-2, [0002].

As for dep. claims 4-6 (part of 1 above), which deals with the determining parameter of step (b), these are well known scenarios and taught in AAPA pages 2-3.

As for dep. claim 5 (part of 1 above), which deals with the communication efficient parameter, i.e. sending a confirming message in response to a reply, this is fairly taught in SCHWARTZ ET AL as shown in paragraphs {[0041]-[0043receipt....]}. Moreover, it would have been obvious to do so if each involved wants to be ensure the communication transmission is ok or received properly.

As for independent method claim 7, which is the combination of claims 1 and 2 above, it's rejected over the rejection of claim 2 shown above.

As for dep. claims 8-10 (part of I above), which have similar limitations to dep. claims 4-6 above, they are rejected for the same reasons set forth in the rejections of claims 4-6 above.

As for system claims 11-16 and 17-20 which are the respective system to carry out the method claims 1-6 and 7-10 above, they are rejected over the system of AAPA /SCHWARTZ ET AL as taught by SCHWARTZ ET AL, see Figs. 1-3 to carry out the communication, to reject the method claims 1-6 and 7-10 as shown above.

6. Claims 5, 9, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /SCHWARTZ ET AL as applied to claims 1-20 above, and further in view of SHIMIZU.

SHIMIZU is cited to teach well known communication step of sending/forwarding a confirmation message to the sender in response to a reply by the sender {see Fig. 3, U5, [0095]-[0098]}. It would have been obvious to modify the teachings of AAPA /SCHWARTZ ET AL by including the well known confirming step as taught by SHIMIZU above for confirming the message if desired.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. US 2002/0049816 by Costin, IV et al teaches the carry out of business campaign using the Internet for lower cost and well known benefits of the Internet.

No claims are allowed.

Art Unit: 3689

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
April 27, 2008